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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,462	02/05/2002	James P. Romano	438P950	8124

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EXAMINER

PERSINO, RAYMOND B

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,462

Applicant(s)

ROMANO ET AL.

Examiner

Raymond B. Persino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: The word "data" is misspelled "date" on the third line of the claim. Also, the word "from" is misspelled "form" on the third line of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over ELBAUM (US 6,010,067 A) in view of DENT (US 5,903,835 A).

Regarding claim 2, ELBAUM discloses a manually portable equipment for wireless transmission and reception of data for verification of credit and/or checking information, said equipment comprising: a) a wireless transceiver (27 of figures 3 and 4); b) a data terminal (17 of figures 3 and 4) including at least one of credit and check data entry means; c) a rechargeable DC battery (25 of figures 3 and 4) external to both said transceiver and said data terminal; d) wiring connecting said battery to both said transceiver and said terminal; said battery providing the sole source of operating power to said transceiver and said data terminal (also see column 3 lines 37 to column 4 line

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51). However, ELBAUM does not disclose that the transceiver is configured to communicate data via direct satellite link from essentially any location in the world. DENT discloses a combined satellite / cellular handset that is configured to communicate data via direct satellite link from essentially any location in the world (column 1 line 65 to column 2 line 39, column 3 line 12 to column 6 line 53 and figure 1). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the transceiver to be configured to communicate data via direct satellite link from essentially any location in the world. Having the ability to communicate via direct satellite link from essentially any location in the world is beneficial in that it would allow the ability to communicate in areas where no other forms of communication exist. Moreover, including terrestrial communications capabilities allows the terrestrial communications system to be used when available. It is preferred to be able to use terrestrial communications when available because using terrestrial communications is less expensive. That said, terrestrial communications systems only have limited coverage and therefore there are places in which terrestrial communications are unavailable. In those places, it would be beneficial to be able to communicate via satellite. Therefore, having the ability to communicate both terrestrially and via satellite, and including the means to appropriately switch between the two types of communications, is beneficial in that allows for the best type of communications to be used in a given location.

Regarding claim 3, see the rejection of the parent claim concerning the subject matter this claim depends from. ELBAUM further discloses that said terminal

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communicates credit card data to said transceiver and receives responding credit card data from said transceiver (column 4 lines 16-67).

Regarding claim 5, see the rejection of the parent claim concerning the subject matter this claim depends from. ELBAUM further discloses including a simulated telephone line connecting said terminal to said transceiver (see elements 35, 53 and 27 of figure 4). See an alternative rejection below.

Regarding claim 6, see the rejection of the parent claim concerning the subject matter this claim depends from. ELBAUM further discloses a cordless telephone connected to said terminal (27 of figures 3 and 4).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over ELBAUM (US 6,010,067 A) in view of DENT (US 5,903,835 A) and further in view of NAIR et al (US 5,444,616 A).

Regarding claim 4, see the rejection of the parent claim concerning the subject matter this claim depends from. However, the prior art cited in the rejection of the parent claim does not disclose including a check reader and associated check reader adapter for generating signals commensurate with indicia printed or encoded on a check and for applying said signals to said transceiver for transmission thereof as at least part of said data. NAIR et al discloses a combined credit card and check reader for generating signals commensurate with indicia printed or encoded on a check and for applying said signals to said transceiver for transmission thereof as at least part of said data (column 4 lines 14-45). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a check reader for

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generating signals commensurate with indicia printed or encoded on a check and for applying said signals to said transceiver for transmission thereof as at least part of said data. Adding the ability to read checks is beneficial in that this is useful to merchants so that they may use a check guarantee service (see NAIR et al, column 1 line 23 to column 2 line 66). Moreover, a combined credit card and check reader saves space (see NAIR et al, column 3 line 49 to column 4 line 11).

4. Claim 5 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over ELBAUM (US 6,010,067 A) in view of DENT (US 5,903,835 A) and further in view of BUSCH, JR et al (US 5,408,513 A).

Regarding claim 5, see the rejection of the parent claim concerning the subject matter this claim depends from. The examiner believes that ELBAUM further discloses including a simulated telephone line connecting said terminal to said transceiver (see elements 35, 53 and 27 of figure 4). See an alternative rejection above. Should the applicant disagree with the examiner and take the position that ELBAUM does not disclose including a simulated telephone line connecting said terminal to said transceiver, BUSCH, JR et al discloses including a simulated telephone line connecting said terminal to said transceiver (see elements 126 and 124 of figure 1). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a simulated telephone line connecting said terminal to said transceiver. The means by which to convey the information from the terminal to the transceiver is a routine engineering decision predicated of the components chosen and form factor. In the instant case, simulating a telephone line allows for any standard

telephone terminal to be used. This is because no special electrical interface would then be required.

Response to Arguments

5. Applicant's arguments filed 8/26/2004 have been fully considered but they are not persuasive. The applicant first argues that the proposed combination does not include a wireless transceiver configured to communicate data via direct satellite link from essentially any location in the world. ELBAUN teaches of a wireless telephone handset but does not teach of satellite link capability. DENT teaches of a wireless telephone handset being including satellite link capability for a telephone handset. It is noted that DENT teaches of multiple embodiments, the examiner is specifically referring to the embodiment discussed in detail in column 3 line 12 to column 6 line 53 and figure 1. Thus, Satellite receiver/transmitter 21 of figure 1 is a wireless transceiver configured to communicate data via direct satellite link from essentially any location in the world.

In response to applicant's second argument, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, having the ability to communicate via direct satellite link from essentially any location in the world is beneficial in that it would allow the ability to communicate in areas where no

other forms of communication exist. Moreover, including terrestrial communications capabilities allows the terrestrial communications system to be used when available. It is preferred to be able to use terrestrial communications when available because using terrestrial communications is less expensive. That said, terrestrial communications systems only have limited coverage and therefore there are places in which terrestrial communications are unavailable. In those places, it would be beneficial to be able to communicate via satellite. Therefore, having the ability to communicate both terrestrially and via satellite, and including the means to appropriately switch between the two types of communications, is beneficial in that allows for the best type of communications to be used in a given location.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond B. Persino whose telephone number is (703) 308-7528. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond B. Persino *RP*
Examiner
Art Unit 2682

RP


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